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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/302,552	04/30/1999	STEPHEN SAVITZKY	15358-46	7040	
20350 7	590 01/13/2003				
TOWNSEND AND TOWNSEND AND CREW, LLP			EXAMINER		
TWO EMBARCADERO CENTER EIGHTH FLOOR NGUYEN		NGUYEN, M	MAIKHANH		
SAN FRANCI	SCO, CA 94111-3834	,	ART UNIT	PAPER NUMBER	
			2176		
			DATE MAILED: 01/13/2003		

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)				
Office Action Summary	09/302,552	SAVITZKY ET AL.	SAVITZKY ET AL.			
	Examiner	Art Unit	-A/			
The MAILING DATE of this communication app	Maikhanh Nguyen	2176				
Period for Reply	Jears on the cover sheet with the	correspondence add	iress			
A SHORTENED STATUTORY PERIOD FOR REPL' THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply - If NO period for reply is specified above, the maximum statutory period of Failure to reply within the set or extended period for reply will, by statute - Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b). Status	36(a). In no event, however, may a reply be a y within the statutory minimum of thirty (30) da will apply and will expire SIX (6) MONTHS from a cause the application to become ABANDON	imely filed ays will be considered timely the mailing date of this co	mmunication.			
1)⊠ Responsive to communication(s) filed on <u>14 I</u>	November 2002 .					
	is action is non-final.					
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. Disposition of Claims						
4) \boxtimes Claim(s) <u>1-12</u> is/are pending in the application	1.					
	4a) Of the above claim(s) is/are withdrawn from consideration.					
5) Claim(s) is/are allowed.						
6)⊠ Claim(s) <u>1-12</u> is/are rejected.						
7) ☐ Claim(s) is/are objected to.						
8) Claim(s) are subject to restriction and/o	r election requirement.					
Application Papers						
9)☐ The specification is objected to by the Examine	r.					
10)☐ The drawing(s) filed on is/are: a)☐ accepted or b)☐ objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
11) The proposed drawing correction filed on		oved by the Examine	er.			
If approved, corrected drawings are required in re						
12) ☐ The oath or declaration is objected to by the Ex	aminer.					
Priority under 35 U.S.C. §§ 119 and 120						
13) Acknowledgment is made of a claim for foreign	n priority under 35 U.S.C. § 119(a)-(d) or (f).				
a) ☐ All b) ☐ Some * c) ☐ None of:						
 Certified copies of the priority document 	s have been received.					
Certified copies of the priority document	s have been received in Applica	tion No				
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 						
14) ☐ Acknowledgment is made of a claim for domesti	·		application)			
a) The translation of the foreign language pro	ovisional application has been re	ceived.	- I-I			
Attachment(s)	. , ,					
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s)	5) Notice of Information	ry (PTO-413) Paper No(s Patent Application (PTC				
J.S. Patent and Trademark Office PTO-326 (Rev. 04-01) Office Ac	etion Summary	Part of	Paper No. 5			

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DETAILED ACTION

1. This action is responsive to communications: amendment A file 11/14/2002 to the original application filed 04/30/1999.

2. Claims 1-12 are currently pending in this application. Claims 10-12 have been added by Applicant. Claims 1 and 9 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Wang et al.** (U.S. 5,237,679 – filed 05/1990) in view of **Schmid et al.** (U.S. 5,569,164 – filed 10/1996) and further in view of **Khan et al.** (U.S. 6,401,206 – filed 03/1998).

As to independent claim 1, Wang teaches in an electronic document handling system, a method of associating documents (it is now possible to electronically group multiple documents together in a manner which is analogous with paper office techniques; col.1, line 55 – col.2, line 12), comprising the steps of:

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- generating a staple data object, for representing an association of selected pages and selected documents (a temporary stapler document relationship may be created by stapling a first document to a second document; col.2, lines 35-56);

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- generating an electronic cover sheet for the staple data object (a temporary electronically designated folder; Abstract /associated pages of a single document can be visually identified and electronically "stapled" or assembled together with appropriate software ... a cover page which contains both machine and human-readable information col.1, line 45 col.2, line 44).
- accepting from a user a list of at least one page of at least one electronic document (document relation object 48 is utilized to describe the logical relationships between the present document and other documents; col.4, lines 52-68);
- accepting a staple instruction from a user (document is stapled to another document; col.4, lines 52-68).

However, Wang does not explicitly teach "referencing each page or each electronic document in the list as an item of the staple data object."

Schmid suggests referencing each page or each electronic document in the list as an item of the stack object (associated pages of a single document can be visually identified and electronically "stapled" or assembled together; col.1, lines 40-50).

It would have been obvious to a person of ordinary skill in the art of the time of the invention was made to combine the teachings of Schmid with Wang because it would have provided the capability for organizing groups of documents when performing electronic stapling.

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The combination of Wang and Schmid do not explicitly "cryptographically securing the staple data object in response to receipt of the staple instruction."

Khan teaches cryptographically securing the staple data object in response to receipt of the staple instruction (simply use digitized version of handwritten signatures and bind it to the electronic document using cryptography; col.1, line 67 – col.2, lines 1-9).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Khan's teaching in the system of Wang as modified by Schmid because it would have provided the enhanced capability for establishing the integrity of document, and ensuring non-repudiation of origin to the extent that it was signed by the user's private key.

As to dependent claim 2, Wang teaches accepting a manually input list (col.4, lines 52-68).

As to dependent claim 3, Wang teaches accepting a computer-generated list (col.4, lines 52-68).

As to dependent claim 4, Wang teaches presenting a user with an online form as an aid to selecting pages or documents for association as a stack (col.5, lines 9-51).

As to dependent claim 5, Wang teaches a step of prompting for the staple instruction by presenting the user with a stapler icon which, when selected, represents the staple instruction (col.4, lines 52-68).

As to dependent claim 6, Wang teaches a step of copying the selected pages and selected documents in a stack to static storage (col.5, lines 9-34).

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As to dependent claim 7, Wang teaches a step of copying the selected pages and selected documents in a stack to a local storage device local to the electronic document handling system (col.5, lines 9-34).

As to dependent claim 8, Wang teaches (col. 6, lines 12-58) displaying a first list of documents, wherein the first list of documents lists the documents that are selected for inclusion in an open stack; displaying a second list of document, wherein the second list of documents list documents that have not been selected for inclusion in an open stack; and displaying a user interface control operative to obtain selections from a user of documents from the second list for inclusion in an open stack.

As to dependent claim 10, Khan discloses using a stack signature to secure the stack object, wherein the stack signature is a checksum of the contents of all the selected pages and selected documents in the stack, signed by the digital signature of a user or the digital signature or private key of a system (the checksum is digitally signed using cryptography; col.2, lines 1-14).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Khan's teaching in the system of Wang as modified by Schmid because it would have provided the enhanced capability for establishing the integrity of document, and ensuring non-repudiation of origin to the extent that it was signed by the user's private key.

As to dependent claim 11, Wang discloses storing the electronic cover sheet in a stack database, where it can be referenced (col.4, lines 1-6).

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As to dependent claim 12, Wang discloses generating controls for adding and deleting selected pages and selected documents from the stack (Version control object; col.5, lines 1-43).

As to independent claim 9, the rejection of independent claim 1 above is incorporated herein in full. However, claim 9 further recites:

- opening a secured stack upon receipt of a stack open instruction;
- presenting the contents of the secured stack for perusal by the user;
- accepting additions and deletions of items on the secured stack; and securing the secure stack upon receipt of a stack restaple operation.

Wang teaches:

- opening a secured stack upon receipt of a stack open instruction; presenting the contents of the secured stack for perusal by the user (a review of the document relation object 48 of FIG. 2 indicates that the document to be deleted forms a portion of a relationship with another document; col.5, lines 57-66);
- accepting additions and deletions of items on the secured stack (reverse search index object 58...support the removal of search index entries...the addition or deletion of data objects; col. 5, lines 19-34); and
- securing the secure stack upon receipt of a stack restaple operation (access control model object 44... contains access control information... identify those users or groups of users to whom some form of access authority to the document has been granted; col.4, lines 37-44).

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Response to Arguments

4. Applicant's arguments filed 11/14/2002 have been fully considered but they are not persuasive.

Applicant argues that neither Wang nor Schmid disclose the claim element "cryptographically securing the staple data object in response to receipt of the staple instruction."

Examiner agrees. Crytography, however, is a well-known technique used to protect a document.

Khan discloses the use of cryptography for securing an electronic document (use digitalized version of handwritten signatures and bind it to the electronic document using cryptography; col.1, line 67- col.2, lines 1-14).

The combination of Wang, Schmid, and Khan meets all limitations as claimed by the Applicant.

Conclusion

- 5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- 6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday Friday from 9:00am 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5403 for regular communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Contact Information:

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks Washington, D.C. 20231

Or fax to:

AFTER-FINAL faxes must be signed and sent to (703) 746-7238. OFFICIAL faxes must be signed and sent to (703) 746-7239. NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

Maikhanh Nguyen January 7, 2003 /JOSEPH H. FEILD RIMARY EXAMINER